



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Akira NAKAJIMA

Group Art Unit: 2814

Application No.: 10/722,609

Examiner: T. Quach

Filed: November 28, 2003

Docket No.: 117894

For: ELECTRONIC DEVICE, METHOD OF MANUFACTURING THE SAME, AND  
ELECTRONIC INSTRUMENT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the November 24, 2004 Restriction Requirement, Applicant provisionally elects Group I, claims 1-19, with traverse.

The Office Action asserts:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process wherein the operating elements are provided over the chip prior to arranging on the circuit board.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The Restriction Requirement is improper and misplaced. As discussed above, the Restriction Requirement asserts that the product as claimed in claims 1-19 can be made by another and materially different process and than the process claimed in claim 20, i.e., the

operating elements are provided over the chip prior to arranging on the circuit board. However, claim 20 does not claim a specific order by which to perform the method. As such, claim 20 is broad enough to include that the product of claim 1 could be made by providing the operating elements over the chip prior to arranging on the circuit board. Because the Restriction Requirement improperly equates an order into the method claimed in claim 20 and has not shown the product as claimed in claims 1-19 can be made by another and materially different process than the process claimed in claim 20, withdrawal of the Restriction Requirement is respectfully requested.

It is also respectfully submitted that the subject matter of all claims is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to the Applicant and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



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JAO:JLC/aaw

Date: December 23, 2004

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